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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/308,451	05/19/1999	ROBERT G. SCHWARTZ	8001.104/00	6174

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CLARENCE A. GREEN
PERMAN & GREEN, LLP
425 POST ROAD
FAIRFIELD, CT 06430

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/308,451

Applicant(s)

SCHWARTZ ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 89-106 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45, 89-106 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

SAM RIMELL
PRIMARY EXAMINER

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Preliminary Note: Applicant's Information Disclosure Statement of February 14, 2003 has been received and fully considered.

Claims 2-6, 8-12, 14-19, 21-24, 27-32, 35-39 and 41-45 are objected to under 37 CFR 1.75 (c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The reasons for this objection were set forth in the Office action of January 2, 2002 and are hereby incorporated by reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 and 89-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitney et al. ('834).

The reasons for the rejection of claims 1-39 were set forth in the office action of January 2, 2002 and are hereby incorporated by reference.

Claims 89-90, 92-93 and 95-96, 101-102 and 104-105 are addressed to the inclusion of a printer and a mailpiece, both of which are features disclosed in Whitney et al. In particular, Whitney et al. discloses a printer (19) and mailpiece (graphically illustrated in FIG 9). In this group of claims, the indicium on the mailpiece is functionally recited as an intended output of the printer, and accordingly, is not attributed patentable weight.

Claims 91, 94, 97-100, 103 and 106 are addressed to a mail piece having the indicium (alternatively referred to as "representation") on the mail piece. These claims invoke

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consideration of *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), since they are addressed to consideration of the patentability of printed matter on a substrate. *In re Gulack* states: “Printed matter that is not functionally related to the substrate does not distinguish invention from prior art in terms of patentability; although printed matter must be considered, in that situation, it may not be entitled to patentable weight.” In the present case of postal elements imprinted upon a mailpiece, examiner finds that the printed matter is not functionally related to the substrate. Evidence of this can be seen from the fact that the printed matter does not alter the function of the mailpiece when it is applied to the mailpiece. In applicant’s invention, the mailpiece is an envelope. The function of an envelope is to serve as a container for relatively small parcels, such as letters. The function of the envelope as a container is not altered by the application of postal indicia. The envelope still remains a container for small parcels, regardless of any indicia applied to its outside surface. Since the functionality of the envelope is not altered by the application of postal indicia, there is apparently no functional relationship between the indicia and its substrate (the envelope). Thus, in accordance with *In re Gulack*, no patentable weight can be attributed to the nature of the printed matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilham (U.S. Patent 5,200,903).

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Gilham discloses a first print head (28) and a second print head (31) separated by a gap (col. 4, lines 24-29). Claims 40-45 are only directed to an apparatus composed of first and second separated print heads. All of the remaining elements are functionally recited and carry no patentable weight.

Remarks

Applicant presents no amendments to the claims in the response of April 21, 2003, but includes arguments addressed to the grounds of objection and rejection.

Applicant takes issue with the Examiner's objection to claims 2-6, 8-12, 14-19, 21-24, 27-32 35-39 and 41-45 under 37 CFR 1.75 (c). Applicant presents arguments based upon recitations from *In re Swinehart* and *In re Schreiber* pointing out that applicant is free to recite features of an apparatus in functional terms. Examiner agrees that applicant may use such claim language, but does not agree that such claim language can be used purely by itself to further define a structure. The problem is not that applicant is using functional language in the first place, but that in certain claims, there are only functional recitations and actually nothing else. Since patentable weight cannot be attributed to the functional recitations as they are claimed, these claims have the effect of presenting no further limitations to the claims from which they depend. This leads to the objection under 37 CFR 1.75 (c).

Applicant also takes issue with the Examiner's refusal to grant patentable weight to the functional language utilized throughout the claims of record, as described in the office action of March 7, 2003. Applicant argues that every single claim limitation must be given patentable weight, including those of which are recited in purely functional terms. Applicant further recites portions of *In re Lowry* and *In re Gulack*.

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The citation from *In re Lowry* is not considered to be relevant to the issues of the present application. *In re Lowry* dealt with questions involving data structures on computer readable medium and whether or not such structures were statutory subject matter under 35 USC 101. The present invention deals with an apparatus that is claiming a functionality of being able to print postal indicia on a substrate, such as an envelope. The present invention does not deal with data on computer readable medium and no questions of statutory subject matter have been raised under 35 USC 101.

The citation from *In re Gulack* calls for the CCPA to “consider all of the claim limitations”. However, the *Gulack* case makes a clear distinction between “considering” language and “giving patentable weight” to language.

To reiterate, *Gulack* includes the following statement:

“Printed Matter that is not functionally related to the substrate does not distinguish the invention from the prior art in terms of patentability; although printed matter must be considered, in that situation, it may not be entitled to patentable weight.” (emphasis added).

From this quotation, it is clear that by “considering” claim language, the Examiner must provide some analysis of the claim language. That is, the Examiner must review the language that is being presented and draw certain conclusions about it. That conclusion does not have to be one that finds that the language limits the scope of protection (carries patentable weight). The Examiner may conclude that that the language does not carry patentable weight.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at (703) 306-5626.


SAM RIMELL
PRIMARY EXAMINER